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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,825	08/06/2003	Akira Nagashima	03500 016040.1	7347
5514	7590	08/15/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SHAH, MANISH S	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,825

Applicant(s)

NAGASHIMA ET AL.

Examiner

Manish S. Shah

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-18,20-22 and 25-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,38 and 50 is/are rejected.
- 7) ☒ Claim(s) 4-18,20-22,25-37,39-49 and 51-53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1, 38 & 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,676,254 B2 in view of Shimada et al. (# US 6302530).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, since the US patent and the application are claiming common subject matter, as follows as shown in Table: 1 below.

TABLE: 1

# US 6676254 B2 CLAIMS	# 10/634,825 CLAIMS
<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii) and; which has a solubility parameter of not less than 15; and(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and <p>wherein the ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin.</p>	<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p> <p>38. An ink cartridge comprising an aqueous ink and ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p> <p>50. An ink tank comprising an aqueous ink, an ink container and ink holding member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii), and <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p>

With respect to claim 1, the pending application claiming the recording method steps, which is almost same as of US patent.

However, the pending application claimed a compound, which is not compatible with (ii), which is broader limitation than the US Patent, so this limitation still can read by the US Patent claim.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition of the US Patent in to the recording method of pending application to get the printed image.

With respect to claims 1, 38 & 50 the pending application claiming (1) the ink cartridge including the ink composition, (2) The ink holding member includes polypropylene.

Shimada et al. teaches that to store the ink, recording apparatus need ink cartridge (ink holding member), wherein ink-holding member is made of polypropylene (column: 8, line: 25-45), which has a low permeability to vapor, and because of that ink can maintain their quality for an extended period of time.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition taught in the US Patent in to the ink cartridge of Omata et al. to get the low coast ink cartridge, and because of the low permeability to vapor, the ink can maintain their quality for an extended period of time (column: 8, line: 40-45).

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3. Claim 1, 38 & 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,676,254 B2 in view of Omata et al. (# US 5953031).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, since the US patent and the application are claiming common subject matter, as follows as shown in Table: 2 below.

TABLE: 2

# US 6676254 B2 CLAIMS	# 10/634,825 CLAIMS
<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with <p>(ii) and; which has a solubility parameter of not less than 15; and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing <p>(i), (ii) and (iii), and</p> <p>wherein the ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin.</p>	<p>1. A recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and the recording medium, the ink being supplied to the recording head from an ink tank comprising an ink contact member and the ink contacting the ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing <p>(i), (ii) and (iii), and</p> <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p> <p>38. An ink cartridge comprising an aqueous ink and ink contact member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing <p>(i), (ii) and (iii), and</p> <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p> <p>50. An ink tank comprising an aqueous ink, an ink container and ink holding member, wherein the ink comprises</p> <ul style="list-style-type: none">(i) a fluorescent coloring material;(ii) a nonionic surfactant;(iii) a compound which is not compatible with (ii); <p>and</p> <ul style="list-style-type: none">(iv) a liquid medium for dissolving or dispersing <p>(i), (ii) and (iii), and</p> <p>wherein the ink contact member is an ink-holding member made of polypropylene.</p>

With respect to claim 1, the pending application claiming the recording method steps, which is almost same as of US patent.

However, the pending application claimed a compound, which is not compatible with (ii), which is broader limitation than the US Patent, so this limitation still can read by the US Patent claim.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition of the US Patent in to the recording method of pending application to get the printed image.

With respect to claims 1, 38 & 50 the pending application claiming (1) the ink cartridge including the ink composition, (2) The ink holding member includes polypropylene.

Omata et al. teaches that to store the ink, recording apparatus need ink cartridge (ink holding member), wherein ink-holding member is made of polypropylene (column: 6, line: 50-62).

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink composition taught in the US Patent in to the ink cartridge of Omata et al. to get the low coast ink cartridge, and because of the high transparency of the polypropylene, the users to visually check an ink remaining amount for convenience of use (column: 6, line: 50-62).

Allowable Subject Matter

4. Claims 4-18, 20-22, 25-37, 39-49 & 51-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 07/05/2006 have been fully considered but they are not persuasive.

6. With respect to claim rejection of Nagashima et al. (254) in view of Omata et al. Applicant argued that the Omata et al. reference and Nagashima et al. reference did not suggest or teach that the ink holding member comprises polypropylene, which is not persuasive. Omata et al. clearly teaches in column: 6, line: 52-61 that "Furthermore, because of small welding area described above, a material, such as polypropylene (P.P.), polybutylene-telephthanol (P.B.T.) or the like, which has high gas barrier capacity to be ideal as a material for the ink tank container but is difficult to use for poor welding ability, can be certainly welded. Particularly, since P.P. material is low in material cost and has high transparency, the tank container formed of the PP material permits the user to visually check an ink remaining amount for convenience of use." So Omata et al. teaches that the ink holding member is made of polypropylene.

Nagashima et al. expressively discloses that the ink holding member made of polyacetate or polyolefin; and the ink of Nagashima et al. is a fluorescent ink.

Nagashima et al. explicitly disclose that to hold the fluorescent ink, you can use any kind of polymer material. However, the new reference Omata et al. explicitly teaches that P.P. material is low in material cost and has high transparency, the tank container formed of the PP material permits the user to visually check an ink remaining amount

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for convenience of use." So Omata et al. teaches that the ink holding member is made of polypropylene. So one of the skilled artisans would know to modify the ink holding member of Nagashima et al. to Omata et al. So it is obvious to modify the ink container of Nagashima et al. with polypropylene taught by Omata et al. reference.

7. With respect to claim rejection of Nagashima et al. (254) in view of Shimada et al. Applicant argued on page 10 of the argument that "the without some specific teaching that polypropylene is an advantageous or suitable material for constructing ink tank and holding an ink containing a fluorescent coloring material." which is not persuasive. Nagashima et al. expressively discloses that the ink holding member made of polyacetate or polyolefin; and the ink of Nagashima et al. is a fluorescent ink. Nagashima et al. explicitly disclose that to hold the fluorescent ink, you can use any kind of polymer material. However, the new reference Shimada et al. explicitly teaches in column: 8, line: 40-45 that with the low vapor permeability of the polypropylene, ink can maintain their quality for an extended period of time, and Shimada et al. teaches that you can hold any kind of ink, they are not limited any particular ink. So one of the skilled artisans would know to modify the ink holding member of Nagashima et al. to Shimada et al. So it is obvious to modify the ink container of Nagashima et al. with polypropylene taught by Shimada et al. reference.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

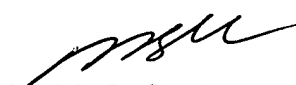
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Manish S. Shah
Primary Examiner
Art Unit 2853

MSS

8/8/06